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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/716,273

11/21/2000

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EXAMINER

IQBAL, KHAWAR

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

06/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/716,273 | Applicant(s) HELAINE ET AL. | |
| | Examiner KHAWAR IQBAL | Art Unit 2617 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-24-08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 23-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C 112 first paragraph, as failing to adequately teach how to make or use the invention, i.e., failing to disclose what is format server has not be defined in the disclosure.

Applicant's disclosure is insufficient to allow one of ordinary skill in the art to make or use the invention without undue experimentation because applicant did not adequately disclose the necessary apparatus to perform the claimed method. See in re Gunn, 190 USPQ 402, 406 (CCPA 1976). In fact applicant's disclosure did not even include the claimed limitations "wherein the protected primary providing data is information establishing a connection to the data network in a home access network" as recited in claims, in the disclosure.

Claims 1,8,15 and 27 are rejected under 35 U.S.C. 112 first paragraph for reasons set forth in the objection to the specification.

It is suggested that applicant could overcome 112 first paragraph rejection by providing a suitably detailed system diagram (with appropriate cross-indexing in the detailed description to reference numerals on said system diagrams.) No new matter should be added.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1,8,15 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,8,15 and 27 recites the limitation "the protected primary providing data" in claim 1, line 11, claim 8, line 11, claim 15, line 11, and claim 27, line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2,4-9, 11-16, 18-21, 25-28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassidy et al (6480725) in view of Karlsson et al (6226523) and Shah (6029065).

Regarding claim 1 Cassidy et al teaches a telecommunication terminal (fig. 1) for accessing a data network via an access data network using a set of provisioning data, the terminal comprising (figs. 1,5-7):

means for storing a current set of provisioning data (Figs. 1,2a, Subscriber data store on the SIM card 10, col. 4, lines 25-57, col. 5, lines 15-28);

means for storing at least one set of protected provisioning data (col. 5, lines 20-54); and

means for selecting a set of provisioning data from a group of the current set of primary provisioning data and the set of protected primary provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

wherein a connection to the network is set up using the selected set of provisioning data (Note: Cassidy et al teach data store in SIM card, used to enable communication on an appropriate network) (col. 4 , lines 52-55). Cassidy et al does not teach one set of provisioning data cannot be updated without the intervention of the terminal user and wherein the protected primary providing data is information establishing a connection to the data network in a home access network.

In a similar field of endeavor, Karlsson et al wherein the protected primary providing data is information establishing a connection to the data network in a home access network (col. 3, lines 15-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Cassidy et al teaches by specifically adding features the protected primary providing data is information establishing a connection to the data network in a home access network in order to filtering data packets transmitted across communication network between mobile station and mobile radio network and Internet protocol type network taught by Karlsson et al. Cassidy et al and Karlsson et al do not teach one set of provisioning data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses one set of provisioning data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al and Karlsson et al to make user friendly by enabling mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claim 8 Cassidy et al teaches a telecommunication terminal for accessing a network via an access data network using a set of provisioning data, the terminal comprising (figs. 1-7):

means for storing a current set of provisioning data (Figs. 1,2a, Subscriber data store on the SIM card 10, col. 4, lines 37-57, col. 5, lines 15-28), means for storing at least one set of protected provisioning data (Figs. 1,3a, ID data store on the EEPROM 6, col. 5, lines 39-54), and

means for selecting a set of provisioning data from a group of the current set of primary provisioning data and the set of protected primary provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

wherein a connection to the data network is set up using the selected set of provisioning data (Note: Cassidy et al teach data store in SIM card, used to enable communication on an appropriate network) (col. 4, lines 52-55). Cassidy et al does not teach one set of provisioning data cannot be updated without the intervention of the terminal user and wherein the protected primary providing data is information establishing a connection to the data network in a home access network.

In a similar field of endeavor, Karlsson et al wherein the protected primary providing data is information establishing a connection to the data network in a home access network and current set of provisioning data comprises roaming information establishing a connection to the data network in a visiting access network (col. 3, lines 15-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Cassidy et al teaches by specifically adding features the protected primary providing data is information establishing a connection to the data network in a home access network in order to filtering data packets transmitted across communication network between mobile station and mobile radio network and Internet protocol type network taught by Karlsson et al. Cassidy et al and Karlsson et al do not teach one set of provisioning data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses one set of provisioning data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al and Karlsson et al to make user friendly by enabling mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claims 15, 27 Cassidy et al teaches a telecommunication terminal for accessing a network via an access data network using a set of provisioning data, the terminal comprising (figs. 1-7):

means for storing a current set of provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

means for storing at least one set of protected provisioning (Figs. 1,3a, element 6, col. 5, lines 39-54);

means for selecting a set of provisioning data from a group of the current set of primary provisioning data and the set of protected primary provisioning data (col. 6, lines 13-26, col. 7, lines 29-43); wherein a connection to the data network is set up using the selected set of provisioning data (Note: Cassidy et al teach data store in SIM card, used to enable communication on an appropriate network)(col. 4, lines 52-55). Cassidy et al does not teach one set of provisioning data cannot be updated without the intervention of the terminal user and wherein the protected primary providing data is information establishing a connection to the data network in a home access network.

In a similar field of endeavor, Karlsson et al wherein the protected primary providing data is information establishing a connection to the data network in a home access network (col. 3, lines 15-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Cassidy et al teaches by specifically adding features the protected primary providing data is information establishing a connection to the data network in a home access network in order to filtering data packets transmitted across communication network between mobile station and mobile radio network and Internet protocol type network taught by Karlsson et al. Cassidy et al and Karlsson et al do not teach one set of provisioning data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses one set of provisioning data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al and Karlsson et al to make user friendly by enabling mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claims 2,9,16 Cassidy et al teaches wherein the terminal is a mobile terminal (Fig. 1).

Regarding claims 4, 11, 18 Cassidy et al teaches wherein the protected provisioning data storage means are adapted to store a plurality of sets of provisioning data for a plurality of accesses to the data network (col. 5, line 15-col. 6, line 35, col. 7, lines 1-50).

Regarding claims 5, 12 and 19 Cassidy et al teaches wherein it includes identification data storage means for each provisioning set stored in the protected provisioning data storage means (col. 5, line 15-54).

Regarding claims 6, 13, 20 Cassidy et al teaches wherein the protected provisioning data storage means are in a medium dedicated to an access network or to an operator (col. 5, line 15-54).

Regarding claims 7 and 21 Cassidy et al teaches wherein the protected provisioning data storage means are in a medium dedicated to an access or content provider (col. 5, line 15-54).

Regarding claim 25 Cassidy et al teaches wherein both the means for storing a current set of provisioning data and the means for storing at least one set of protected provisioning data are located in at least one of storage of the terminal and on a card insertable into the terminal (col. 6, lines 13-26, col. 7, lines 29-43).

Regarding claim 26 Cassidy et al teaches wherein the means for storing a current set of provisioning data and the means for storing at least one set of protected provisioning data, each store data for setting up a connection to the data network via a respective access networks for the same terminal and wherein connections to different access networks are established with different stored sets of provisioning data (col. 6, lines 13-26, col. 7, lines 29-43).

Regarding claim 28 Cassidy et al teaches wherein, when the terminal returns to a home access network, said one of said at least one set of protected primary provisioning data is copied from the protected storing means into the current storing means (col. 6, lines 13-26,col. 7, lines 29-43).

Regarding claim 32 Cassidy et al wherein the current set of primary provisioning data is updated automatically without intervention of the terminal user (col. 6, lines 13-26,col. 7, lines 29-43, see claim 1).

6. Claims 23-24, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassidy et al (6480725) in view of Shah (6029065).

Regarding claims 23, 30 and 31 Cassidy et al teaches a method of accessing a network by a telecommunication terminal, the method comprising (figs. 1-7):

identifying a user and a network using the terminal (Figs. 1,3a, col. 5, lines 39-54, col. 1, line 63-col. 2, line 65);

when the user and the network are identified, checking storage for a protected provisioning data (col. 6, lines 13-26,col. 7, lines 29-43);

when said provisioning data is detected, using said provisioning data; and
when said provisioning data is not detected, requesting current provisioning data (col. 6, lines 13-26);

wherein said storage is in one of: the terminal; a medium dedicated to an access provider; a medium dedicated to an access network (col. 6, lines 13-26, col. 7, lines 29-43), wherein before storing in said storage said protected provisioning data, the user is queried whether said protected provisioning data is to be stored (col. 6, lines 13-26,col. 7, lines 29-43). Cassidy et al does not teach data cannot be updated without the intervention of the terminal user.

In a similar field of endeavor, Shah discloses data that cannot be updated without the intervention of the terminal user (col. 8, lines 32-47). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al to enable mobile users to readily access network features across multiple networks without requiring the user to learn additional feature codes.

Regarding claim 24 Cassidy et al teaches wherein the provisioning data is primary provisioning data to access the data network (col. 6, lines 13-26).

7. Claims 3, 10, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cassidy et al (6480725) in view of Karlsson et al (6226523) and Shah (6029065), and further in view of Beaudou (6671522).

Regarding claims 3, 10, 17, the combination of Cassidy et al, Karlsson et al and Shah do not specifically teach packet switched data network. In a similar field of endeavor, Beaudou discloses packet switched data network (col. 9, line 35-col. 10, line 35, col. 8, lines 13-50). At the time of the invention it would have been obvious to one of ordinary skill in the art to modify Cassidy et al and Shah to include connection to the data network for using information for the purpose of allowing connection in a packet switched data using Internet protocol or wireless application protocol.

Response to Arguments

8. Applicant's arguments with respect to claims 1-21, 23-28, 30-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is (571)272-7909. The examiner can normally be reached on 9 am to 6.30 pm Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GEORGE ENG can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 2617

/K. I./

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